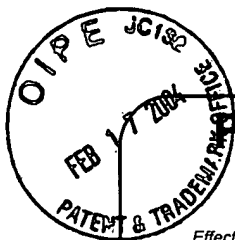


TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/021,292
		Filing Date	October 29, 2001
		First Named Inventor	Milberger, Susan M.
		Art Unit	3624
		Examiner Name	Akers, Geoffrey R.
Total Number of Pages in This Submission	22	Attorney Docket Number	020375-000240US

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Return Postcard Appendix: List of Pending Claims
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.
<div style="text-align: right;">RECEIVED FEB 26 2004 GROUP 3600</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual	Townsend and Townsend and Crew LLP Thomas D. Franklin Reg. No. 43,616
Signature	
Date	February 17, 2004

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02-19-04

PTO/SB/17 (10-03)

AF/3624

**FREE TRANSMITTAL
for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** 330

Complete if Known

Application Number	10/021,292
Filing Date	October 29, 2001
First Named Inventor	Milberger, Susan M.
Examiner Name	Akers, Geoffrey R.
Art Unit	3624
Attorney Docket No.	020375-000240US

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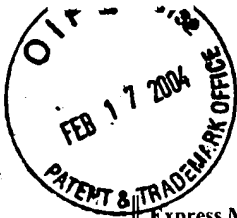
GROUP 3600

METHOD OF PAYMENT (check all that apply)					
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<input checked="" type="checkbox"/> Deposit Account:					
Deposit Account Number		20-1430			
Deposit Account Name		Townsend and Townsend and Crew LLP			
The Director is authorized to: (check all that apply)					
<input checked="" type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments					
<input checked="" type="checkbox"/> Charge any additional fee(s) or any underpayment of fee(s)					
<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.					
FEE CALCULATION					
1. BASIC FILING FEE					
Large Entity		Small Entity			
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)
2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE					
Total Claims		Extra Claims	Fee from below	Fee Paid	
Independent Claims					
Multiple Dependent					
Large Entity		Small Entity			
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)
**or number previously paid, if greater; For Reissues, see above					

FEE CALCULATION (continued)					
3. ADDITIONAL FEES					
Large	Entity	Small	Entity	Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Petitions related to provisional applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					
*Reduced by Basic Filing Fee Paid					SUBTOTAL (3) (\$)
					330

SUBMITTED BY				Complete (if applicable)	
Name (Print/Type)	Thomas D. Franklin	Registration No. (Attorney/Agent)	43,616	Telephone	303-571-4000
Signature				Date	February 17, 2004

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PATENT
Attorney Docket No.: 020375-000240US

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GROUP 3600

TOWNSEND and TOWNSEND and CREW LLP

By: 
Cindy Bennett

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS**

In re application of:

Milberger et al.

Application No.: 10/021,292

Filed: October 29, 2001

For: SUBSCRIPTION-BASED PAYMENT

Examiner:

Colbert, ELLA
Geoffrey R. Akers

Art Unit:

3624

APPELLANT'S BRIEF
UNDER 37 CFR §1.192

MAIL STOP: Appeal Brief - Patents
Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

Appellant offers this brief in furtherance of the Notice of Appeal mailed on January 15, 2004 in the above-referenced case. This brief is submitted in triplicate as required by 37 CFR 1.192(a).

REAL PARTY IN INTEREST:

First Data Corporation is the real party in interest for this appeal.

02/24/2004 CNBUEY 00000047 201430 10021292
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RELATED APPEALS AND INTERFERENCES:

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

STATUS OF CLAIMS:

Claims 1-27 are currently pending in the application, but stand rejected by the Examiner. Claims 1-10 and 12-20 are as originally filed in the application on October 29, 2001. Claim 11 was amended and claims 21 and 22 were added in the response to the first Office Action mailed on January 9, 2003. Claims 23-27 were added in response to the non-final Office Action that was filed June 5, 2003. No claims have been canceled.

Claims 1-27 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as Appendix A.

STATUS OF AMENDMENTS:

There is no controversy over the status of claims 1-27 since no amendments were proposed after the final Office Action of July 15, 2003.

SUMMARY OF THE INVENTION:

In one embodiment, the claimed invention relates to using an online money transfer system **100** to automatically process a recurring transfer request from a stored value

fund. Application, claim 1. Within the online money transfer system 100, a stored value fund is maintained that receives a transfer from any one of a number of money handlers 160 in a first transfer. Id., page 3, first full paragraph. In the transfer transaction, the payor is informed that the payee accepts payment from the online system 100. Id., Fig. 11A, step 1104.

Subscription type information is received by the online money transfer system 100 from the payor to, for example, set rules for the recurring transfer. Id., Fig. 11A, steps 1116, 1120, and 1124. Types of subscription type information include at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period. Id., claim 1. For example, the automated transfer could be \$50 limit per month time period.

To initiate one of the recurring transfers, the online money transfer system 100 receives pay-out instructions from the payee when a recurring payment is due. Id., Fig. 11B, step 1140. The pay-out instructions include at least two of a payor identifier, a payee identifier, a transfer amount, and a payment description. Id., claim 1. With the particulars of the transfer, the payment can be automatically transferred from the stored value fund to the payee. Id., claim 1; and Fig. 11B, step 1164.

Other embodiments and embellishments are possible for the invention. For example, some embodiments allow a veto period that allows the payor the ability to decline the recurring transfer submitted by the payee. Id., claim 17. The payor is reminded of the transfer and a period of time is waited before the transfer is made to the payee. Id. Other embodiments and embellishments are, or course, still within the scope of the claimed invention.

ISSUES:

Issue I: Whether under 35 U.S.C. §103(a) claims 1-27 are unpatentable over cited portions of U.S. Patent No. 6,347,305 to Watkins et al. (hereinafter "Watkins") in view of cited portions of U.S. Patent No. 6,438,586 to Hass (hereinafter "Hass") and further in view of cited portions of U.S. Patent No. 6,408,204 to Hilt (hereinafter "Hilt"). Paragraphs 4-6 of the final Office Action, mailed July 15, 2003, describe the Examiner's current position on this issue.

Issue II: Whether under 35 U.S.C. § 101 claims 10,16 and 20 are not patentable subject matter because they have no utility and fail to describe a concrete, useful and tangible output. The Examiner's position on this rejection is presented in paragraphs 7-9 of the final Office Action mailed on July 15, 2003.

GROUPING OF THE CLAIMS:

Appellant submits that the claims do not stand or fall together for the reasons set forth in the Argument section. For the purposes of this appeal, the claims are grouped as follows:

Group I: Claims 1-9, 11-15 and 23-26 stand or fall together.

Group II: Claims 17-19, 21 and 22 stand or fall together.

Group III: Claims 10, 16 and 20 stand or fall together.

Although certain claims are grouped above to stand or fall together, Appellant reserves the right outside the context of this appeal to argue independent patentability of any grouped claims.



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GROUP 3600

APPENDIX: LIST OF PENDING CLAIMS

Attorney Docket No.: 020375-000240US

Application No. 10/021,292

Page 15 of 20

1. (Original) A method for automatically processing a recurring transfer request from a stored value fund with an online system, the method comprising:

- determining a handler associated with a payor;
- transferring money from the handler to the stored value fund;
- informing the payor that a payee accepts payment from the online system;
- receiving subscription type information which includes at least two of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
- receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description; and
- transferring the transfer amount from the stored value fund to the payee automatically.

2. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second stored value fund associated with the payee.

3. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

4. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the second-listed transferring step comprises transferring the transfer amount to a second handler associated with the payee.

5. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 4, wherein

the second handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

6. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program.

7. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, further comprising a steps of:

sending notification to the payor after receiving the pay-out instructions;
waiting a period of time between the sending step and the second-listed transferring step;

canceling the second-listed transferring step if the payor declines within the period of time.

8. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the transfer amount corresponds to at least one of: currency, monetary value, airline mileage, promotional program points, gift certificate credit, and commodities.

9. (Original) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the payor, the handler and the payee are remotely located with respect to each other.

10. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the recurring transfer request from the stored value fund with the online system of claim 1.

11. (Previously Amended) A method for automatically processing a transfer request from a stored value fund with an online system, the method comprising:

- determining a handler associated with a payor;
- transferring money from the handler to the stored value fund;
- informing the payor that a payee accepts payment from the online system;
- receiving subscription type information which includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
- receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description; and
- transferring the transfer amount from the stored value fund to a second handler associated with the payee automatically.

12. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

13. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the second handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program, a gift certificate issuer, an electronic gift certificate issuer, and a money order issuer.

14. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, wherein the handler includes at least one of a bank, a credit card company, a debit card company, an agent location, a stored value fund, and an airline mileage program.

15. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 11, further comprising a steps of:

- sending notification to the payor after receiving the pay-out instructions;
- waiting a period of time between the sending step and the second-listed transferring step;
- canceling the second-listed transferring step if the payor declines within the period of time.

16. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the transfer request from the stored value fund with the online system of claim 11.

17. (Original) A method for automatically processing a transfer request from a stored value fund with an online system, the method comprising:

- determining a handler associated with a payor;
- transferring money from the handler to the stored value fund;
- informing the payor that a payee accepts payment from the online system;
- receiving subscription type information which includes at least one of a per-request payment cap, a fixed payment amount, a limit on payment per time period, a limit on the number of payments in the time period, and a time period;
- receiving pay-out instructions that include at least two of a payor identifier, a payee identifier, a transfer amount, a payment description;
- sending notification to the payor after receiving the pay-out instructions;
- waiting a period of time between the sending step and the second-listed transferring step;
- transferring the transfer amount from the stored value fund to the payee; and
- canceling the second-listed transferring step if the payor declines within the period of time.

18. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step does not require any human interaction to fulfill the pay-out instructions.

19. (Original) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step comprises transferring the transfer amount to a second handler associated with the payee.

20. (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for automatically processing the transfer request from the stored value fund with the online system of claim 17.

21. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the second-listed transferring step comprises a step of transferring the transfer amount in a plurality of transfers.

22. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, further comprising a step of checking the pay-out instructions against the subscription type information.

23. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the determining step comprises a step of determining by the online system a handler previously associated with a payor.

24. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the stored value fund is hosted by the online system.

25. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, wherein the receiving steps receive information online at the online system.

26. (Previously Presented) The method for automatically processing the recurring transfer request from the stored value fund with the online system as recited in claim 1, further comprising a step of determining if the transfer amount violates any limits specified in the subscription type information.

27. (Previously Presented) The method for automatically processing the transfer request from the stored value fund with the online system as recited in claim 17, wherein the fixed payment amount is a per-request limit.

ARGUMENT**I. Issue I, Group I: Obviousness Rejection of Claims 1-9, 11-15 and 23-26**

The final Office Action again rejected claims 1-9, 11-15 and 23-26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,347,305 to Watkins et al. in view of U.S. Patent No. 6,438,586 to Hass and further in view of U.S. Patent No. 6,408,204 to Hilt. Appellant believes a *prima facie* case of obviousness has not been properly set forth in the final Office Action with regard to a rejection of claims 1-9, 11-15 and 23-26. The patent office is charged with putting forth a *prima facie* showing of obviousness. The basic test is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision February 2003.

Appellant believes that the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness.

Teachings Missing from the Cited References

With regard to the third prong of the test, Appellant believes that the cited sections of Watkins (“Watkins”), the cited sections of Hass et al. (“Hass”), and the cited sections

of Hilt et al. ("Hilt") do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, none of Watkins, Hass or Hilt teach or suggest: (1) receiving subscription type information for the recurring transfers as required by claims 1, 11 and 17; and (2) transfer of money from the handler to a stored value fund and transfer from the stored value fund to the payee as generally required by claims 1, 11, and 17. For least these reasons, Appellant respectfully requests overturning the rejection of the claims.

Summary of Cited References

Watkins addresses allowing payroll deductions to finance purchases. According to a payday schedule, money is deducted from a payor's paycheck. Deductions in this manner are not transfers. The amount in the paycheck is merely reduced. Presumably, at some point, the merchant/payee is paid for the goods corresponding to the deductions, but it is not clear from Watkins how this is handled. For example, one could surmise that the transfer to the merchant/payee is performed after all the paycheck deductions have occurred.

Hass relates to a method for communication between a plurality of processors. Files are transferred to effectuate this communication. These files appear unrelated to the transfer of money. There is no contemplation of online money transfers in this reference. Hass is non-analogous art.

In Hilt, a bill pay system is described. This system presents each bill to the payor for manual approval of the pay order. The approved bills are paid with bank account money transfers for the approved amount. A payment message can be cancelled out where the source account has non-sufficient funds (NSF). The payor has no ability to cancel an approved bill.

Some embodiments of Hilt use a settlement bank 128 between the payor bank 16 and the payee bank 18, but this is not a stored value fund, but merely a settlement account.

First Missing Limitation: Subscription Type Information

Claims 1 and 11 require receiving subscription type information for the recurring transfers. None of the references contemplate recurring transfers being performed automatically. Hilt is cited by the Office Action for teaching this limitation because a bill payment order contains a payment amount and a date. See Hilt, col. 13, lines 60-62. Appellant believes reliance on Hilt for this teaching is not reasonable. Hilt does teach manual approval by the payor of a bill pay order with a specified amount with a desired transaction date, but that is not the same thing. The specified amount is determined by the payee in Hilt and it is not a limit, but a set amount. There is no reason an amount less than the specified amount would be used, such that there is no defined limit. Further, the desired transaction date in Hilt is just that and not a time period.

Hilt is further cited for teaching subscription information based upon the use of the term "transaction counts" in Fig. 6. These words appear nowhere in the text of the Hilt and no explanation of these terms is given in the discussion of Fig. 6. Appellant has no idea why transaction counts are determined as processing totals, perhaps it is mere status information, but, in any event, there is no limit or subscription type information that can be implied from use of this term in Fig. 6. Appellant believes reliance upon Hilt to teach subscription type information that limits transfers is not reasonably supportable.

Second Missing Limitation: Two Transfers

Claims 1 and 11 generally require two transfers. One to from a handler to a stored value account and another from the stored value account to the payee. Watkins is apparently cited in the Office Action for the first transfer and Hass is apparently cited for the second transfer in section 6 of the final Office Action and Hilt is cited for two transfers in section 9 of the final Office Action. Appellant believes the file transfer of Hass does not in fact effectuate the transfer of money as is required by the claims. Further, Hilt teaches use of a settlement bank 128 between the payor bank 16 and the payee bank 18, but the settlement bank 128 of Hilt is not a stored value account as is claimed. Neither the payor or payee have access to the settlement bank 128 such that it cannot act as a stored value account.

Motivation to Combine Watkins & Hass

The first prong of the test requires, a suggestion or motivation to combine references to avoid hindsight reconstruction of the claimed invention based upon the information disclosed in the present application. The last four sentences of section 6 of the Office Action appear to address the motivation to combine Watkins, Hass and Hilt, but Appellant cannot discern the nature of this argument. The following excerpt is believed apt in the present case:

"In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination

is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985)

No Motivation to Use Hass in any Combination

With regard to Hass, it is not clear how communication between processes taught in Hass would have any applicability to recurring money transfers. Any general motivation in Hass does not address the specific combination of elements from Hass with the other references. It is not clear how the cited portion in the summary section of Hass that relate to storage systems and transferring information would provide any motivation for one of ordinary skill in the art to combine these references.

Further, Hass is non-analogous art and not directed to the particular problem for which the invention is concerned. The following excerpt is quoted and explained in MPEP, Original Eighth Edition Rev 1, February 2003, § 2141.01(a):

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)

As Hass is non-analogous art, it has nothing to do with the problems solved by the invention. Hass relates transferring information between processes running on different host processors. Hass, col. 1, lines 6-9. There is no contemplation in Hass of money transfers, let

alone recurring money transfers. It would not occur to one of ordinary skill in art to even look to Hass for any teachings relating to money transfers.

No Motivation to Use Hilt in Any Combination

The motivation to combine Hilt with the other references is the following cited sentence: "An improved bill paying system is provided by virtue of the present invention." Hilt is a bill payment system, Hass is a payroll deduction payment method, and Watkins is a data storage system. Limitations from Hilt are combined from the other references. How could one skilled in the art be motivated to make that specific combination with only the general motivation to improve a bill paying system?

Hindsight Reconstruction

The only way this combination of Watkins, Hass and Hilt makes any sense is to use the Appellant's claims as a template, which is impermissible hindsight reconstruction. Specific motivation relevant to the claimed limitations is respectfully requested in any further decision or office action.

Reasonable Likelihood of Success in Combining Watkins, Hass & Hilt

The second prong of the test requires a reasonable likelihood of success. Combining the payroll deduction of Watkins with the data storage method of Hass and the bill payment system of Hilt is confusing to explain, at best, and requires major modifications to each reference. Payroll deduction systems and bill payment methods of Watkins and Hilt are very different from the file transfer systems of Hass. Such major modifications these references would have little likelihood of success. How would one of ordinary skill in the art hope to combine these references with any likelihood of success? The combination would produce a

payroll deduction system that would have a data storage system running on a plurality of host processors that could also allow bill payment functionality. One of ordinary skill in the art would not be able to these references in the suggested manner with any likelihood of success.

For at least the forgoing reasons, Appellant believes any obviousness rejection of claims 1-9, 11-15 and 23-26 is believed improper.

II. Issue I, Group II: Obviousness Rejection of Claim 17-19, 21 and 22

The final Office Action again rejected claims 17-19, 21 and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,347,305 to Watkins et al. in view of U.S. Patent No. 6,438,586 to Hass and further in view of U.S. Patent No. 6,408,204 to Hilt. Appellant believes a *prima facie* case of obviousness has not been properly set forth in the final Office Action with regard to a rejection of claims 17-19, 21 and 22. The basic test for a *prima facie* obviousness rejection is excerpted in the section above.

Teachings Missing from the Cited References

With regard to the third prong of the test, Appellant believes that the cited sections of Watkins ("Watkins"), the cited sections of Hass et al. ("Hass"), and the cited sections of Hilt et al. ("Hilt") do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, none of Watkins, Hass or Hilt teach or suggest: (1) receiving subscription type information for the recurring transfers as required by claim 17 as discussed in the preceding section; (2) transfer of money from the handler to a stored value fund and transfer from the stored value fund to the payee as generally required by claim 17 as discussed in the preceding section; and (3) waiting a period of time before the transfer and canceling the transfer

if the payor declines in that period of time as required by claim 17. For least these reasons, Appellant respectfully requests overturning of the rejection to claims 17-19, 21 and 22.

First Missing Limitation: Subscription Type Information

Claim 17 require receiving subscription type information for the recurring transfers. This limitation is not taught or suggested in the cited references as fully discussed in the preceding section above.

Second Missing Limitation: Two Transfers

Claim 17 generally requires two transfers. This limitation is not taught or suggested in the cited references as fully discussed in the preceding section above.

Third Missing Limitation: Veto Period

Claim 17 waits a period of time to allow the payor to decline the transfer. As can be appreciated by those skilled in the art, when subscription payments are configured to be automatically paid, the payor may want to cancel the subscription when reminded of a soon to be executed payment. The claim requires "waiting a period of time." Hilt does automatically cancel a transfer where there is NSF, but this is not what is claimed. See Hilt, col. 16, lines 58-61; and col. 17, line 55 through col. 18, line 9. There is no waiting a time period in this Hilt just a variable delay associated with the administrative handling of the bank transfer. Further, it is the payor bank that generates the NSF condition that would cancel the transfer. The claim allows the payor to decline the transfer within the period of time. The payor is not given the ability to cancel a bill once approved as required by claim 17.

For at least the forgoing reasons, Appellant believes any obviousness rejection of claims 17-19, 21 and 22 is improper.

Motivation to Combine / Likelihood of Success

These two prongs of the *prima facie* obviousness test are fully discussed in the preceding section and not reiterated here.

III. Issue II, Group III: Utility Rejection of Claims 10, 16 and 20

Claims 10, 16 and 20 are rejected under 35 U.S.C. §101 as they allegedly lack utility and fail to describe a concrete, useful and tangible output. These claims in question are dependent computer program product claims or, so-called, Beauregard claims. The claimed item is embodied on a computer-readable medium that includes computer-executable instructions for performing the steps recited in their respective parent method claim. The concrete, useful and tangible output includes the substantial utility of transferring value between parties when the program instructions are executed. As those skilled in the art appreciate, the transfer of value is the heart of commerce and the software that effectuates this process is of equal value.

It is now well settled law that Beauregard claims have utility. To wit, "the Commissioner now states 'that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. Section 101 and must be examined under 35 U.S.C. Sections 102 and 103.'" In re Beauregard, 35 USPQ2d 1383, 1384 (CAFC 1995). Accordingly, Appellant respectfully requests that the rejection of Claims 10, 16 and 20 be overturned. Further, if the rejection is not overturned, further explanation is requested as to why these Beauregard claims are considered to have no utility.

For at least the forgoing reasons, Appellant believes the utility rejection of claims 10, 16 and 20 to be improper.

CONCLUSION:

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the final Office Action dated July 15, 2003 and the Advisory Action dated February 4, 2004. Please deduct the requisite fee, pursuant to 37 C.F.R. §1.17(c), of \$320.00 from deposit account 20-1430 and any additional fees associated that may be due in association with the filing of this Brief. This Brief is submitted in triplicate.

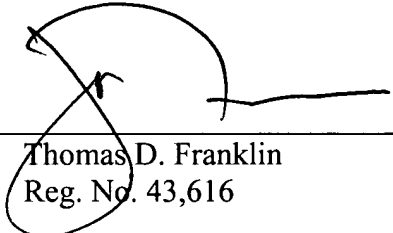
If for any reason the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

Date: February 17, 2004

By


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